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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,569	08/06/2001	Kenichi Sakuma	862.C2324	7063
5514	7590	07/17/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			RUHL, DENNIS WILLIAM	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/921,569		SAKUMA ET AL.	
	Examiner		Art Unit	
	Dennis Ruhl		3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant's amendment of 4/27/06 has been entered. Currently claims 43-60 are pending.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 47,53,59, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 47,53,59, it is not clear as to what an "estimate mail" is. What is this? This has been interpreted to be simply the transferring of the estimate to the user (the terminal they are using).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 48,54,60, are rejected under 35 U.S.C. 102(e) as being anticipated by Li (6609050)

For claims 48,54,60 Li discloses an information processing apparatus 10 that has a check unit (module 41) that determines whether or not a product is under warranty or not. Also see column 4, lines 26-28 and column 6, lines 49-51. Column 8, lines 6-23

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disclose that a repair fee estimate is generated. If the repair is covered under warranty the customer does not have to pay so there is no estimate. Li discloses a 1st presentation unit, which is the interface that the user sees when the estimate is displayed, such as shown in figure 7 and 9. This limitation is only reciting the ability of the presentation unit to display certain things, one being information about a method of recovering a product. The presentation unit of Li has this ability. Patentable weight is not given to the kinds of data that the display is intended to present. Limitations of this nature are simply directed to the intended use of the presentation unit. Additionally, Li discloses that if the repair is covered under warranty, the customer is informed of where they can go to get the repair performed. This satisfies the "method of recovering the product" limitation.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 43-47,49-53,55-59, are rejected under 35 U.S.C. 103(a) as being unpatentable over Li (6609050) in view of Wong (5432904).

For claims 43,45,46,47,49,51,52,53,55-59, Li discloses an information processing apparatus 10 that has a check unit (module 41) that determines whether or not a product is under warranty or not. Also see column 4, lines 26-28 and column 6, lines 49-51. Column 8, lines 6-23 disclose that a repair fee estimate is generated. Li discloses a 1st presentation unit, which is the interface that the user sees when the estimate is displayed, such as shown in figure 7 and 9. The display of the computer is capable of displaying a repair fee estimate as claimed. Not disclosed is that there is a determination unit that determines if the repair fee estimate is higher than a predetermined fee. Wong discloses an auto repair estimating system and provides estimates for auto repairs. Wong discloses that the system has the ability to compare the cost for repairing a part of a vehicle to the cost of replacing the vehicle to see which one is cheaper and is a better decision (a determination module). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Li with a determination module that determines whether or not the cost of a repair is greater than a predetermine fee, such as the cost of replacing a part, so that it can be seen which is cheaper. If it costs more to repair a part than to simply replace the part, one would surely want to have the part replaced, because the cost is cheaper and you get a totally new part. With respect to the language reciting that the 1st presentation unit

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is adapted to present a repair fee estimate, Li discloses this ability due to the fact that an estimate is provided. With respect to the limitation that information about new products is presented, this is non-functional descriptive material that does not distinguish from the prior art. The apparatus claim 43 only recites the ability of the presentation unit to display certain things, one being information about new products. The presentation unit of Li has this ability. Claim 49 recites the presenting of information about new products; however, this is non-functional descriptive material because the information about new products is not used in any further method steps and is just descriptive data concerning what is displayed. Additionally, Li discloses that if the repair is covered under warranty, the customer is informed of where they can go to get the repair performed. This satisfies the "method of recovering the product" limitation.

For claims 44,50, the 2nd presentation unit/step is considered to be the interface that displays data to the user informing them that the product is under warranty. This satisfies what is claimed. Additionally, as stated with respect to claim 1, the claim only recites the 2nd presentation unit as having the ability to display a method of recovering the product, which is more intended use language for the 2nd presentation unit.

8. Applicant's arguments with respect to the newly added claims have been considered but are moot in view of the new ground(s) of rejection.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DENNIS RUHL
PRIMARY EXAMINER